

REMARKS

The filing of the instant response, on September 22, 2003, must be considered to have been timely filed in accordance with the provisions of MPEP 510 -Filing Of Papers During Unscheduled Closings Of The U.S. Patent And Trademark Office which states:

37 CFR 1.9(h) provides that the definition of "Federal holiday within the District of Columbia" includes an official closing of the Office. When the entire U.S. Patent and Trademark Office is officially closed for business for an entire day, for reasons due to adverse weather or other causes, the Office will consider each such day a "Federal holiday within the District of Columbia" under 35 U.S.C. 21. Any action or fee due on such a day may be taken, or fee paid, on the next succeeding business day the Office is open.

The Examiner's non-final Office Action dated June 18, 2003 has been received and its contents carefully noted. Accordingly, claims 1-3, 10 and 20 have been amended and new claim 23 has been added to set forth another feature of the invention. The Examiner's indication that claims 3, 4, 7, 8, 10, 12, 13, 17 and 19 would be allowable if presented in independent form including the limitations of the base claim and any intervening claim is greatly appreciated. However, the Applicants have not taken such action at this time since the independent claims 1, 9, 20, 21 and 22 are believed patentable over the prior art of record in light of the above amendments and comments to follow. Please note that support for the amendments to claims can be found in the specification at least at paragraphs [0017], [0042] and [0051]-[0054]. The Applicants respectfully request reconsideration and withdrawal of the rejections of record.

With regard to the Examiner's comments regarding a claim for priority to related German application 199 15 066.4/52, filed April 1, 1999 and the requirement for a new oath or declaration properly setting forth the claim for priority, the Examiner's attention is directed to the Request for Corrected Official Filing Receipt (copy attached), filed June 28, 2002, which included an Application Data Sheet and requested that the Official Filing Receipt, mailed March 19, 2002, be corrected to properly indicate the related German application 199 15 066.4/52, filed April 1, 1999, to which "priority not claimed." Consequently, the no claim for priority exists in the instant application and further a new oath/declaration is not required. Correction of the USPTO electronic records, consistent with the Request for

Corrected Official Filing Receipt of June 28, 2002 is respectfully requested.

With regard to the Examiner's objection to the specification, at page 8, for having the "...reference numerals 19-21 have been used to designate both 'recesses' and 'light'", the Applicants have amended paragraphs [0039] and [0040] to clearly set forth that "recesses 19, 20 and 21" permit "the passage of light" which is consistent with the discussion of the operation of the pipetting or dosing system of the invention at paragraph [0054]. Withdrawal of the objection to the specification is respectfully requested.

Turning to the Examiner's rejection of:

Claims 1, 2, 5, 6, 11, 18 and 20-22, under 35 U.S.C. 102(b), as being anticipated by the teachings of Schurbrock ('661), and

Claims 14-16, under 35 U.S.C. 103(a), as being obvious in view of the teachings of Schurbrock ('661),

each of these rejections is traversed.

The presently claimed invention method of detecting the type of replaceable piston-cylinder unit mounted in a pipetting or dosing apparatus requires the following steps:

- a) inserting the piston-cylinder unit in the apparatus;
- b) fixing the cylinder of the piston-cylinder unit in the apparatus;
- c) coupling the piston rod head with the apparatus;
- d) detecting the presence of the piston-cylinder unit in the apparatus;

and, following the above mentioned sequence of steps comprising the steps of:

e) generating a relative movement between the piston rod head and the detection device and detecting a reference point on the piston head with the detection device; and

f) generating a relative movement between the piston rod head and the detection device and detecting a code marking on the piston rod head to determine the type of piston-cylinder unit mounted in the apparatus;

wherein the steps e) and f) occur in any time sequence. (emphasis added)

while the presently claimed pipetting or dosing apparatus set forth the following features:

a removably mountable piston-cylinder unit formed as a replaceable part, and which comprises a piston with a piston rod and a piston rod head which is provided with a code marking specifying the type of piston-cylinder unit and a reference point detectable from laterally of the piston;

a detection device for automatically detecting the code marking and the reference point of the piston when the piston-cylinder unit is mounted on the apparatus;

a drive device for generating relative movement between the piston rod head and the detection device for enabling the reference point and the code marking to be position for detection by the detection device; and

an evaluating unit for evaluating the code marking with respect to the reference point. (emphasis added)

Similarly, claims 20-22 set forth a replaceable piston-cylinder unit which requires:

"a cylinder and a piston inside the cylinder...provided with a piston rod and a piston rod head,

wherein the piston rod head is provided with a code marking by which the type of the piston-cylinder unit is identifiable..." (emphasis added)

A detailed review of the Schurbrock reference reveals that the patentee does not teach (explicitly or implicitly) the above highlighted features and further does not suggest the modifying the disclosed method and apparatus to arrive at the claimed features.

Specifically, as noted by the Examiner, Schurbrock teaches placing the code marks, i.e., higher sensed areas 9, on the flange 7 of the cylinder 2 of the piston-cylinder unit 1. Further, the patentee teaches that determining the data of the code mark occurs upon assembly movement of the piston-cylinder unit, particularly the flange 7, into the accommodation unit 23. That is, unlike the claimed method, Schurbrock clearly teaches (see column 5, line 62, to column 14) that the action of fixing the piston-cylinder unit within the accommodation unit 23 causes the sensing means 11 to be activated by the collapse of knots 15 and completion of the electrical paths 17 and 13. This enables the higher sensed areas (code marks) 9 on the flange to be sensed which can be evaluated and the dosage in the syringe displayed.

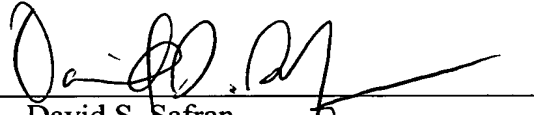
Therefore, not only does Schurbrock fail to teach the methodology of amended claim 1, but the patentee also fails to teach the code marks being placed onto the piston rod head as specified by claims 9 and 20-22. Further, Schurbrock does not provide any motivation/suggestion to one of ordinary skill in the prior art to modify its teachings to place the higher sensed areas (code marks) onto the piston rod head 6 or to modify the patentee's process such that movement of the piston head relative to the detecting device, after fixing the cylinder in the dosing or pipetting apparatus, results in detection of the higher sensed area (code marks) on the piston rod head, as presently claimed.

Consequently, since Schurbrock does not teach each feature of the claimed invention, anticipation cannot exist and the rejection, under § 102(b), is improper and must be withdrawn. Additionally, since Schurbrock does not provide any suggestion or motivation to one of ordinary skill in the prior to modify its teachings to arrive at the features of independent claim 1, 9 and 20-22, a *prima facie* case of obviousness also does not exist, and the rejection, under § 103(a), is also improper and must be withdrawn.

While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise, which could be eliminated through discussions with applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited..

Respectfully submitted,

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